

ESTTA Tracking number: **ESTTA559681**

Filing date: **09/16/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Naked Wines, LLC
Granted to Date of previous extension	09/15/2013
Address	1767 12th Street Hood River, OR 97031 UNITED STATES

Attorney information	Hillary A. Brooks Marger Johnson & McCollom PC 210 SW Morrison Street Suite 400 Portland, OR 97204 UNITED STATES hillary.brooks@techlaw.com, amanda.bernardy@techlaw.com, litigationdocketing@techlaw.com Phone: 503-222-3613
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Applicant Information

Application No	85679897	Publication date	03/19/2013
Opposition Filing Date	09/16/2013	Opposition Period Ends	09/15/2013
Applicant	Diageo North America, Inc. 801 Main Avenue Norwalk, CT 06851 UNITED STATES		

Goods/Services Affected by Opposition

Class 033. All goods and services in the class are opposed, namely: Alcoholic beverages, except vodka and beers
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
Other	Likelihood of confusion with opposer's family of marks

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3597649	Application Date	05/02/2008
Registration Date	03/31/2009	Foreign Priority	NONE

		Date	
Word Mark	NAKED WINERY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2005/11/18 First Use In Commerce: 2005/11/30 wine; natural wines; table wines; white wine; and red wine		

U.S. Registration No.	3502269	Application Date	12/18/2006
Registration Date	09/16/2008	Foreign Priority Date	NONE
Word Mark	NAKED WINERY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2007/07/05 First Use In Commerce: 2007/07/05 wine; natural wines; table wines; white wine; and red wine		

U.S. Registration No.	3677064	Application Date	08/07/2007
Registration Date	09/01/2009	Foreign Priority Date	NONE
Word Mark	NAKED WINERY NAUGHTY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2009/06/29 First Use In Commerce: 2009/06/29 Wine; natural wines; table wines; white wine		

U.S. Registration No.	3828747	Application Date	11/30/2007
Registration Date	08/03/2010	Foreign Priority Date	NONE
Word Mark	NAKED WINERY DIVA		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2010/04/13 First Use In Commerce: 2010/04/16 wine; natural wines; table wines; and red wine		

U.S. Registration No.	3693297	Application Date	11/28/2007
Registration Date	10/06/2009	Foreign Priority Date	NONE
Word Mark	NAKED WINERY VIXEN		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 033. First use: First Use: 2009/06/26 First Use In Commerce: 2009/06/26 wine; natural wines; table wines; and red wine
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U.S. Registration No.	3558709	Application Date	11/28/2007
Registration Date	01/06/2009	Foreign Priority Date	NONE
Word Mark	SIP INTO SOMETHING A LITTLE MORE NAKED		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 033. First use: First Use: 2007/07/05 First Use In Commerce: 2007/07/05 wine; natural wines; table wines; white wine; and red wine		

Related Proceedings	91210699, 91208796
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Attachments	6512-0068 Notice Of Opposition.pdf(25964 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Hillary A. Brooks/
Name	Hillary A. Brooks
Date	09/16/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No.: 85/679,897

Filed: July 18, 2012

Published: March 19, 2013

For the mark: DON'T WORRY. DRINK NAKED. AT THE NAKED RUM COMPANY WE BELIEVE THAT RUM, LIKE LIFE, IS BEST ENJOYED NAKED. THAT'S WHY, UNLIKE MOST RUMS, THE NAKED TURTLE NEVER TOUCHES THE INSIDE OF AN OAK BARREL. OUR RUM IS DISTILLED FIVE TIMES WITH THE PRISTINE WATERS OF THE VIRGIN ISLANDS AND THE FINEST SUGARCANE MOLASSES, THEN BOTTLED "NAKED", RESULTING IN A RUM SO DELICIOUS YOU CAN DRINK IT NEAT, OR MIXED IN YOUR FAVORITE NAKED RUM COCKTAIL. WE THINK IT'S AS GOOD AS RUM GETS. RUM PRODUCED IN ST CROIX, USVI, BOTTLED BY THE NAKED RUM CO., LAWRENCEBURG, IN (& design)

Class: 33

Naked Wines, LLC)	
)	Opposition No. _____
Opposer,)	
)	
v.)	
)	
Diageo North America, Inc.,)	
)	
)	
Applicant.)	

NOTICE OF OPPOSITION

1. Naked Wines, LLC an Oregon limited liability company having its principal place of business at 1767 12th Street, Hood River, Oregon 97031 ("Opposer"), believes that it is damaged by registration of the mark DON'T WORRY. DRINK NAKED. AT THE NAKED RUM COMPANY WE BELIEVE THAT RUM, LIKE LIFE, IS BEST ENJOYED NAKED. THAT'S WHY, UNLIKE MOST RUMS, THE NAKED TURTLE NEVER TOUCHES THE INSIDE OF AN OAK BARREL. OUR RUM IS DISTILLED FIVE TIMES WITH THE PRISTINE WATERS OF THE VIRGIN ISLANDS AND THE FINEST SUGARCANE MOLASSES, THEN BOTTLED "NAKED", RESULTING IN A RUM SO DELICIOUS YOU CAN DRINK IT NEAT, OR MIXED IN YOUR FAVORITE NAKED RUM COCKTAIL. WE THINK IT'S AS GOOD AS RUM GETS. RUM PRODUCED IN ST CROIX, USVI, BOTTLED

BY THE NAKED RUM CO., LAWRENCEBURG, IN (& design) (referred to as “DON’T WORRY. DRINK NAKED.”) that is the subject of U.S. Trademark Application Serial No. 85/679,897 (“’897 application”) for “Alcoholic beverages, except vodka and beers” by Diageo North America, Inc., a Connecticut corporation having an address at 801 Main Avenue, Norwalk, Connecticut 06851, (“Applicant”). The ’897 application was filed July 18, 2012. Opposer opposes registration of the ’897 application.

As first grounds for opposition, Opposer alleges as follows:

2. Opposer owns U.S. Trademark Registration No. 3,597,649 for the mark NAKED WINERY for wine; natural wines; table wines; white wine; and red wine. Opposer owns U.S. Trademark Registration No. 3,502,269 for the design mark NAKED WINERY for wine; natural wines; table wines; white wine; and red wine. Opposer owns U.S. Trademark Registration No. 3,677,064 for the mark NAKED WINERY NAUGHTY for wine; natural wines; table wines; white wine; and red wine. Opposer owns U.S. Trademark Registration No. 3,828,747 for the mark NAKED WINERY DIVA for wine; natural wines; table wines; white wine; and red wine. Opposer owns U.S. Trademark Registration No. 3,693,297 for NAKED WINERY VIXEN for wine; natural wines; table wines; white wine; and red wine. Opposer owns U.S. Trademark Registration No. wine; natural wines; table wines; white wine; and red wine. Opposer owns U.S. Trademark Registration No. 3,558,709 for the mark SIP INTO SOMETHING A LITTLE MORE NAKED for wine; natural wines; table wines; white wine; and red wine. Collectively, Opposer’ referred to in this Notice of Opposition as “NAKED WINERY Marks”.

3. Applicant’s mark DON’T WORRY. DRINK NAKED. so resembles Opposer’s previously registered NAKED WINERY Marks as to be likely, when used on or in connection with the goods or services of the Applicant, to cause confusion, mistake or deception.

As second, alternative, grounds for opposition, Opposer alleges as follows:

4. Opposer, since prior to Applicant’s filing date or any date of first use upon which Applicant can rely, has used and not abandoned the NAKED WINERY Marks as a trademark for wine.

5. Applicant's mark DON'T WORRY. DRINK NAKED. so resembles Opposer's NAKED WINERY Marks as to be likely, when used on or in connection with the goods or services of the Applicant, to cause confusion, mistake or deception.

As third, alternative, grounds for opposition, Opposer alleges as follows:

6. Opposer is the owner of a family of NAKED marks including NAKED WINERY, NAKED WINERY NAUGHTY, NAKED WINERY DIVA NAKED WINERY VIXEN, and SIP INTO SOMETHING A LITTLE MORE NAKED for wine.

7. Opposer, since prior to Applicant's filing date or any date of first use upon which Applicant can rely, has used and promoted its marks NAKED WINERY, NAKED WINERY NAUGHTY, NAKED WINERY DIVA NAKED WINERY VIXEN, and SIP INTO SOMETHING A LITTLE MORE NAKED as a family of marks.

8. Applicant's mark DON'T WORRY. DRINK NAKED. is so similar to Opposer's family of marks that, when used on or in connection with the goods or services of the Applicant, is likely to be perceived as another member of Opposer's family of marks, and is likely to cause confusion, mistake or deception.

As fourth, alternative, grounds for opposition, Opposer alleges as follows:

9. Applicant's mark DON'T WORRY. DRINK NAKED. when used on or in connection with the goods of the Applicant is merely descriptive.

Opposer prays that this opposition is sustained and that registration to the Applicant is refused.

Respectfully submitted,

MARGER JOHNSON & McCOLLOM, P.C.

/Hillary A. Brooks/
Hillary A. Brooks
Registration No. 45,815
Attorney for Opposer

MARGER JOHNSON & McCOLLOM, P.C.
210 SW Morrison Street, Suite 400
Portland, OR 97204
(503) 222-3613

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing NOTICE OF OPPOSITION was served upon Applicant on September 16, 2013 by forwarding said copy via first class mail to the Attorney of Record at the following address:

NICOLE D. D'AMATO
DIAGEO NORTH AMERICA, INC.
801 MAIN AVE
NORWALK, CONNECTICUT 06851-1127

By: /Amanda K. Bernardy/
Amanda K. Bernardy